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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,589	11/10/2003	William B. Rose	1201.68221	6235
24978	7590	11/16/2007	EXAMINER	
GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				NGUYEN, CHI Q
ART UNIT		PAPER NUMBER		
		3635		
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11/16/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/705,589	ROSE, WILLIAM B.
	<b>Examiner</b>	<b>Art Unit</b>
	Chi Q. Nguyen	3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 August 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 5,16-25,30,55-64,67 and 68 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,6-15,26-29,31-54,65 and 66 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 1/22/2007
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

This Office action is in response to applicant's amendment filed 9/10/2007.

### ***Status of Claims***

Claims 1-4, 6-15, 26-29, 31-54, and 65 are pending and have been examined.

Claims 5, 16-25, 30, and 67-68 have been cancelled.

Claims 55-64 have been withdrawn.

### ***Claim Rejections - 35 USC § 102***

Claims 1, 2, and 8 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,718,088 to Jacobsen.

#### **Claim 1:**

Jacobsen discloses in Fig. 1 a preformed unibody diverter for directing water away from a building foundation comprising a generally vertical section 10/15 having a first predetermined width; first 15 and second 10 portions of said generally vertical section disposed at an angle with respect to one another, an angled section 13 extending downwardly from said generally vertical section at an obtuse angle therewith and having a second predetermined width, wherein said angled section includes first and second portions disposed at an obtuse angle with respect to one another, and wherein said second predetermined width is larger than said first predetermined width.

#### **Claim 2:**

Wherein said first and second portions 10/15 are disposed at a generally right angle (or 90-degrees) with respect to one another (Fig. 1).

Claim 8:

Wherein said vertical section has a predetermined thickness.

Claims 1, 2, 8, 11-15, 26-27, 33-35, 37-39, 44-46, 52-54, and 65 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,178,369 to Syx.

Claims 1, 8, 54, and 65:

Syx discloses in Fig. 5 a fence vegetation barrier 60 comprising a generally vertical section 62/64 disposed at an angle with respect to one another having a first predetermined width, an angled section 68 extending downwardly from said generally vertical section at an obtuse angle therewith and having a second predetermined width, wherein said angled section includes first 66 and second 68 portions disposed at an obtuse angle with respect to one another, and wherein said second predetermined width is larger than said first predetermined width and Fig. 11 shows vertical portion has an abutment angle of 180-degrees and four bodies around a house foundation structure.

Claim 2:

Wherein said first and second portions 62/64 are disposed at a generally right angle (or 90-degrees) with respect to one another (Fig. 5 and col. 4, lines 55-56).

Claim 11:

Wherein said vertical section comprises PVC (see abstract).

Claims 12-15, 33-34, 44, 45, 52, and 53:

Wherein said vertical section includes an attachment system includes at least one fastener, bolt, or threaded fastener (see col. 4, lines 10-13).

Claims 26-27, 35, 37-39, and 46:

Syx shows in Fig. 15 a preformed diverter system comprising a first, a second and a third diverter are installed around a house having a body includes a generally L-shaped and an angled portion that extends downwardly and away from the vertical portion (see Fig. 5).

Claims 65 and 66 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6,199,326 to Mayle.

Mayle discloses in Figs. 1 and 4 a diverter 10 comprising a vertical portion 81/82 and an angled portion 83/84 that extends downwardly and away from the vertical portion 81/82 and further comprising a through-cut 86a/86b.

***Claim Rejections - 35 USC § 103***

Claims 3-7, and 9-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,718,088 to Jacobsen.

Claims 3-4, 6-7 and 9:

Jacobsen discloses the basic structures for the flashing as stated above but does not disclose that the vertical section has a width of approximately ten inches, angled section has width of approximately 30 inches, the first and second portions of said vertical section have a predetermined length of approximately 24 inches, wherein said angled portion extends downwardly from said vertical portion at a grade of

approximately 20%, and wherein said vertical section has a predetermined thickness of approximately 0.045 inches. However, these features would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made. Furthermore, applicant has not disclosed the criticality of these features.

Claims 10 and 11:

Jacobsen discloses the basic structures for the flashing as stated above but does not disclose that the angled portion comprises rubber and the vertical section comprises PVC. However, these features would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made. Furthermore, applicant has not disclosed the criticality of these features.

Claims 3-4, 6-7, 9, 28-29, 31-32, 36, 40-43, and 47-51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,178,369 to Syx.

Syx discloses the basic structures for the flashing as stated above but does not disclose that the vertical section has a width of approximately ten inches, angled section has width of approximately 30 inches, the first and second portions of said vertical section have a predetermined length of approximately 24 (claim 32), 27 (claim 43), 44 (claim 51) inches, wherein said angled portion extends downwardly from said vertical portion at a grade of approximately 20%, wherein a ratio of the widths of said vertical section and said angled section of said second unibody diverter body is between approximately 1:1 and 1 : 10, and wherein said vertical section has a predetermined thickness of approximately 0.045 inches. However, these features would have been a matter of obvious design choice to one of ordinary skill in the art at the time the

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invention was made. Furthermore, applicant has not disclosed the criticality of these features.

### ***Response to Arguments***

Applicant's arguments filed 8/23/2007 have been fully considered but they are not persuasive.

Applicant argues Jacobsen's device is not concerned with a building foundation but instead concerned with a roof flashing, and not unibody. Examiner does not agree with the applicant's argument because of the claims are not drawn to a combination with a building foundation and Fig. 1 of Jacobsen clearly shows a device is an unibody although in col. 3, lines 21-22 state that the three elements are welded together; as examiner's interpretation the three parts are welded "preformed" to make an "unibody" thus the prior met the claimed requirement.

Applicant argues Syx's device is used for fence vegetation barrier and does not contemplate using anything around a foundation of a house. Again, the claims are not drawn to a combination with a building foundation thus applicant's argument is not persuasive.

Applicant argues Mayle's device is not configured to surround a cylindrical post of a building foundation. Applicant's argument is not persuasive because the claims are not drawn to a combination with a building foundation.

Applicant argues with respect to particular dimensions in the claims is that it would have been within the skill of an ordinary artisan in the art in view of Jacobsen. However, Jacobsen concerns roof flashings. The particular dimensions and angles of

claims 3, 4 and 7 are likely unsuitable for the roofing applications contemplated with Jacobsen. An artisan looking to modify the roofing structure of Jacobsen would not contemplate these dimensions. Nor would an artisan even be motivated to apply the roofing flashing of Jacobsen to water diversions from a building foundation as there is no motivation or indication that Jacobsen's structures are suitable for building foundation protection. And Syx is concerned with providing a vegetation barrier and an aid to mowing and weed whacking. Also, Syx' devices are used above ground, and would be limited in the ratios of sizes that could be used or the device would become obtrusive and would fail to perform the purposes intended in Syx. For example, if the lower section was 30" long and the angles in Syx were maintained, Syx' device would extend well away from the fence or the building and that is not an intended result in Syx. Making it such a size would interfere with grass cutting, for example, and would also extend the vegetation barrier a significant distance away from the fence or a building and would be unattractive. Syx discloses nothing for use with respect to a building foundation and nothing that is intended to be used underground. Examiner does not agree with applicant's argument because as set forth above the claims are drawn to a subcombination of a diverter and not positively combined with a building foundation thus with respect to a changing dimensions to fit for a desirable application (e.g. a building foundation post) would have been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

*Ex Parte Masham, 2 USPQ F.2d 1647 (1987).*

The rejection is sustained and will be made it final.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairdirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

CQN

11/2/2007

/J. CHAPMAN/  
PRIMARY EXAMINER  
ART UNIT 3633